

## **REMARKS**

Independent claims 1, 14, and 18 have been amended to clarify the element of the outcome of an instant game being independent from a base wagering game and the entry of the base wagering game being displayed along with the result of the instant game. Claims 2-13, 15-17, and 19-20 have been amended to be in proper dependent format. Claims 1-20 are now pending in the present application.

### **Office Action of June 30, 2005**

Applicant has carefully reviewed and considered the Office Action of June 30, 2005. Applicant hereby requests entry of this Amendment and further consideration of the present application in view of the following remarks.

In the Office Action, claims 14 and 18 were objected to for informalities, claims 1-8 and 10-20 were rejected under 35 U.S.C. §102(e) as being anticipated by Caro et al. (U.S. Pat. Application Publication 2003/0050109), and claims 9 and 13-20 were rejected under 35 U.S.C. §103(a) as being unpatentable over Penrice (U.S. Pat. Application Publication 2004/0266514) in view of Caro et al. Applicant respectfully traverses these grounds of rejection in view of the above amendments and following remarks and requests reconsideration thereof.

### **Claim Objections**

The Office Action rejected claims 14 and 18 for the informality of a lack of antecedent basis for the element "the display unit." Claims 14 and 18 have been amended and the ground of rejection has been removed. Therefore, Applicant respectfully suggests that their objections have been overcome.

### **Rejection under 35 U.S.C. §102(e)**

The Office Action stated Caro et al. discloses all elements of claims 1-8 and 10-12. Applicant respectfully disagrees and requests reconsideration in view of the above amendments and the following remarks.

### Claim 1

The Office Action rejected claim 1 under 35 U.S.C. §102(e) as being unpatentable over Caro et al. Caro et al. discloses a combined lottery and optional instant game using a central computer and multiple game terminals (Abstract). A user may play a future draw game and an instant game in one ticket and the instant game involves matching a first set of player-selected number from the draw game with a second set of the like-type of numbers randomly generated ([0048]). As it is shown in FIGs. 2[A-B] through 8[A-B] and FIGs. 9-10 in Caro et al., the outcome of the instant game is dependent on the numbers selected by the user for the first game. A player wins the instant game by matching a first set of number selected for the draw game with a second set of numbers that are randomly drawn ([0057]).

Caro et al., however, does not disclose storing a plurality of instant win game outcome displayer themes. Applicant has reviewed the cited paragraphs, [0041], [0045], and [0046] and does not discern where such element is disclosed. Caro et al. also does not disclose displaying the outcome of the instant win game with a theme as claimed in the present invention. As matter of matter, the outcomes of the instant game in Caro et al. are displayed without any theme.

Conversely to Caro et al., amended claim 1 is directed to a method for playing an instant win game with a base wagering game, where the outcome of the instant win game is independent from the base wagering game. As shown in FIG. 9, a player may play a Keno game, and then participate in an instant game with a football game theme ([0081]). The outcome of the instant game and its theme are independent from the game that the player selected to play. The outcome of the instant game is also displayed with a theme, such as football game (FIG. 9), black jack game (FIG. 10), or bingo game (FIG. 11).

In order to anticipate the present invention, the suggested combination must disclose all elements of the claim (MPEP §2131). Applicants submit that the elements of the outcome of the instant game being independent from a base game, storing a plurality of instant win game outcome display themes, and displaying the outcome of the instant win game with a theme are not disclosed or suggested by Caro et al. Applicants further submit that the amendments do not add new material and are fully

supported by the specification ([0081]). Therefore, claim 1, as amended, is patentable over Caro et al., and allowance thereof is requested.

#### Claims 2-4, 7, and 10-12

The Office Action rejected claims 2-4, 7 and 10-12 for the same reasons stated for claim 1. Applicants respectfully disagree.

Claims 2-4, 7 and 10-12 depend from claim 1 and further add steps to the method of claim 1. Therefore, Applicants submit that claims 2-4, 7 and 10-12 are patentable over the cited references for at least reasons stated above with respect to the patentability of amended claim 1, and the allowance thereof is requested.

#### Claims 5-6

The Office Action stated that Caro et al. discloses the outcome of the instant win game being displayed with one of the instant win game outcome display themes corresponding to the store game theme indicator. However, after reviewing the cited figure and the related description, Applicant does not discern where in the reference such element is disclosed. Applicant submits that, as stated with respect to the patentability of claim 1, Caro et al. does not disclose such element and cannot anticipate claims 5-6 (MPEP §2131). Therefore, Applicant respectfully requests this rejection be withdrawn and claims 5-6 allowed.

#### Claims 8

The Office Action stated that Caro et al. discloses storing a plurality of instant win game outcome display themes at the plurality of terminal units. However, after reviewing the cited figure and the related description, Applicant does not discern where in the reference such element is disclosed. Applicant submits that, as stated with respect to the patentability of claim 1, Caro et al. does not disclose such element and cannot anticipate claim 8 (MPEP §2131). Therefore, Applicant respectfully requests rejection be withdrawn and claim 8 allowed.

Rejection under 35 U.S.C. §103(a)

The Office Action stated the combination of Penrice and Caro et al. renders claims 9 and 13-20 obvious. Applicant respectfully disagrees and requests reconsideration in view of the above amendments and the following remarks.

Claims 9 and 13

Claims 9 and 13 depend from claim 1 and further add elements to claim 1. Therefore, Applicants submit that claims 9 and 13 are patentable over the cited references for at least reasons stated above with respect to the patentability of amended claim 1 and the allowance thereof is requested.

Claim 14

The Office Action stated that claim 14 is unpatentable in view of the combination of Penrice and Caro et al. However, in order to render a claim obvious, the cited references must teach or suggest all elements of the rejected claim (MPEP §2142). As discussed with respect to the patentability of amended claim 1, Caro et al. does not disclose at least the elements of the outcome of the instant game being independent from a base game, storing a plurality of instant win game outcome display themes, and displaying the outcome of the instant win game with a theme, and Applicant submits that these elements are also not disclosed or suggested by Penrice. Therefore, because Penrice and Caro et al., either individually or in combination, do not teach or disclose all elements of claim 14, as amended, Applicant respectfully requests rejection be withdrawn and claim 14 allowed.

Claim 15

Claim 15 depends from claim 14 and further adds elements to claim 14. Therefore, Applicants submit that claim 15 is patentable over the cited references for at least reasons stated above with respect to the patentability of amended claim 14, and the allowance thereof is requested.

#### Claim 16

The Office Action stated that Caro et al. discloses the outcome of the instant win game being displayed with one of the instant win game outcome display themes corresponding to the store game theme indicator. Yet, as discussed above with respect to the patentability of claim 14, Applicant does not discern where in the reference such element is disclosed. Applicant submits that, as stated with respect to the patentability of claim 14, Penrice and Caro et al., either individually or in combination, do not teach or disclose such element and cannot render claim 16 obvious (MPEP §2142). Therefore, Applicant respectfully requests this rejection be withdrawn and claim 16 allowed.

#### Claim 17

The Office Action stated that Penrice and Caro et al. disclose a terminal unit controller programmed to store a plurality of instant win game outcome themes at the terminal unit memory device. However, after reviewing the cited figure and the related description, Applicant does not discern where in the reference such element is disclosed. Applicant submits that, as stated with respect to the patentability of claim 14, Penrice and Caro et al., either individually or in combination, do not disclose such element and cannot render obvious claim 17 (MPEP §2142). Therefore, Applicant respectfully request rejection be withdrawn and claim 17 be allowed.

#### Claim 18

The Office Action stated that the combination of Penrice and Caro et al. renders claim 18 obvious. However, in order to render a claim obvious the cited references must teach or suggest all elements of the claim (MPEP §2142). As discussed with respect to the patentability of amended claim 1, Caro et al. does not disclose at least the elements of the outcome of the instant game being independent from a base game, storing a plurality of instant win game outcome display themes, and displaying the outcome of the instant win game with a theme, and Applicant submits that these elements are also not disclosed or suggested by Penrice. Therefore, in view that Penrice and Caro et al., either individually or in combination, do not teach or disclose

all elements of claim 18, as amended, Applicant respectfully requests this rejection be withdrawn and claim 18 allowed.

#### Claim 19

Claim 19 depends from claim 18 and further adds elements to claim 18. Therefore, Applicants submit that claim 19 is patentable over the cited references for at least reasons stated above with respect to the patentability of amended claim 18 and the allowance thereof is requested.

#### Claim 20

The Office Action stated that Penrice and Caro et al. disclose a controller programmed to display the outcome of the instant win game with an instant win game outcome display theme. However, after reviewing the cited figure and the related description, Applicant does not discern where in the reference such element is disclosed. Applicant submits that, as stated with respect to the patentability of claim 20, Penrice and Caro et al., either individually or in combination, do not disclose such element and cannot anticipate claim 20 (MPEP §2142). Therefore, Applicant respectfully requests this rejection be withdrawn and claim 20 allowed.

#### Conclusion

In view of the foregoing remarks, Applicant respectfully submits that Claims 1-20, as amended, are in condition for allowance and entry of the present amendment and notification to that effect is earnestly requested. If necessary, the Examiner is invited to telephone Applicant's attorney (404-815-3383) to facilitate prosecution of this application.

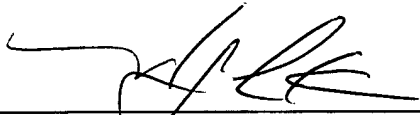
No additional fees are believed due. However, the Commissioner is hereby authorized to charge any additional fees that may be required, including any necessary extensions of time, which are hereby requested to Deposit Account No. 03-0683.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner of Patents, Alexandria, VA 22313-1450, on this \_\_\_\_ day of July, 2005.



Lucille Golden-Blakey